

REMARKS

Claim 10 is canceled without prejudice, and therefore claims 8, 9 and 11 to 16 are now pending in the present application.

It is respectfully requested that the present application be reconsidered since all of the presently pending claims are allowable.

Applicants thank the Examiner for indicating the claim 10 contains allowable subject matter. While the objection to claim 10 (and the rejections of claims 1 and 2 to 9) may not be agreed with, to facilitate matters, claims 9, 11 and 15 have been rewritten to include the features of claim 10, which has been canceled without prejudice. Accordingly, claims 9, 11 and 15 are allowable, as are their respective dependent claims. It is therefore respectfully requested that the objection be withdrawn.

Claims 8, 9, 15 and 16 were rejected under 35 U.S.C. § 102(a) as anticipated by Chemisky (DE '418).

Claims 11 to 14 were rejected under 35 U.S.C. § 103(a) as anticipated by Chemisky (DE '418) in view of the Igashira reference.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Actions to date do not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

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While the rejections of claims 8, 9 and 11 to 16 may not be agreed with, to facilitate matters, claims 9, 11 and 15 have been rewritten to include the features of claim 10, which has been canceled without prejudice. Accordingly, claims 9, 11 and 15 are allowable, as are their respective dependent claims.

It is therefore respectfully requested that the anticipation and obviousness rejections be withdrawn.

Accordingly, claims 8, 9 and 11 to 16 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 8, 9 and 11 to 16 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

Dated: _____

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By: _____

Gerard A. Messina
Gerard A. Messina
Reg. No. 35,952
One Broadway
New York, NY 10004
(212) 425-7200
*Reg. no. 33,865
Hann C
Gresitca)*

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